

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that the term “substantially” in claims 1 and 17 is a relative term that renders the claim indefinite. Although, Applicants respectfully disagree with the Examiner’s arguments, in the interests of advancing prosecution, claims 1 and 17 have been amended to delete the term “substantially.” Accordingly, it is respectfully requested that the rejection of claims 1 and 17 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner also rejects claims 1 and 17 under 35 U.S.C. § 112, second paragraph, because the Examiner is not clear how the tapered portion can be both “included in the soft portion” and “disposed forward of the soft portion.” In response, claims 1 and 17 have been amended to delete the recitation of the tapered portion being disposed forward of the soft portion. Accordingly, it is respectfully requested that the further rejection of claims 1 and 17 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner now rejects claims 1-4 and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,083,549 to Cho et al., (hereinafter “Cho”). Additionally, the Examiner also now rejects claims 5-16 under 35 U.S.C. § 103(a) as being unpatentable over Cho in view of U.S. Patent No. 5,084,022 to Claude (hereinafter “Claude”).

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. The Examiner argues that all of the features of independent claims 1 and 17 are shown in Cho. The Applicant respectfully disagrees.

Firstly, the Examiner argues that the tapered portion of Cho is disclosed as being separated 70 cm or less from the distal end. Applicant could find no such disclosure in Cho. The tapered portion of Cho is indicated in Figure 5b by reference numeral 70, which is not an indication of a dimension and only a reference numeral.

Secondly, the Examiner argues that Cho discloses an insertion unit (68) having a small-diameter portion (72), a large-diameter portion (12) and a tapered portion (70). However, the large-diameter portion (12) of Cho is described therein as a handle and is not part of the insertion unit (12). Claims 1 and 17 have been amended to clarify that the large-diameter portion is a part of the insertion unit. The clarifying amendment to claims 1 and 17 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the amendment to claims 1 and 17.

A feature of the endoscope and the insertion unit for an endoscope recited in claims 1 and 17, respectively, is that in order to improve the insertability into a body portion, such as the large intestine, the tapered portion is provided in the soft section, such as in the middle, and the small diameter portion and the large diameter portion are provided distally and proximally, respectively, with respect to the tapered portion so that operation at the proximal side may be easily transmitted to the distal side.

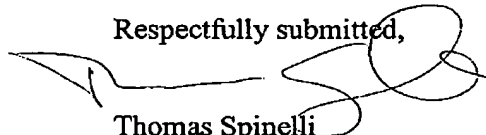
With regard to the rejection of claims 1-4 and 17 under 35 U.S.C. § 102(b), an endoscope and the insertion unit for an endoscope having the features discussed above and as

recited in independent claims 1 and 17, respectively, is nowhere disclosed in Cho. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 1 and 17 are not anticipated by Cho. Accordingly, independent claims 1 and 17 patentably distinguish over Cho and are allowable. Claims 2-4 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-4 and 17 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 5-16 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 5-16 are at least allowable therewith because they depend from an allowable base claim.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).